

Application Ser. No. 10/729,576  
Rule 116 Amendment and Response

Attorney Docket No.: 60409CON(50370)

**REMARKS**

Claims 1-4 and 6-42 are pending in the application. Claims 1, 6, 8-10, 14, 22, 26, 35 and 36 have been amended and claims 7, 11-13, 21 and 39-42 have been cancelled without prejudice or disclaimer. Accordingly, claims 1-4, 6, 8-10, 14-20 and 22-38 will be pending in the application upon entry of the claim amendments presented herein.

Amendment and cancellation of the claims are not to be construed as acquiescence to any rejections set for the in the instant Office Action or any previous Office Action and were done solely to expedite prosecution of the application. Applicants reserve the right to pursue the cancelled claims or similar claims in one or more further patent applications.

***Interview***

Applicants take this opportunity to thank Examiner Li for the courteous and helpful telephonic interview on October 16, 2006 with Peter C. Lauro, Esq. And Melissa Hunter-Ensor, Ph.D.

***Acknowledgement of Priority Claim and Compliance with 37 C.F.R. §1.78***

On page 3, item 5 of the Continuation Application Transmittal Form under Rule 1.53(b) (copy enclosed) filed concurrently with the instant application on December 1, 2003, Applicants requested that the specification be amended by inserting before the first line the paragraph:

"This application is a continuation application of application no. 09/658,765, filed September 8, 2000, which claims priority to provisional application no. 60/153,300, filed September 10, 1999. The contents of the aforementioned applications are herein incorporated by reference."

Applicants respectfully request the Examiner to acknowledge that the foregoing specification amendment has been made. If the specification has not already been amended and a formal amendment is required, Applicants request that the Examiner notify the undersigned who will provide the formal amendment as soon as possible. If such a formal amendment is required, Applicants submit that amending the application at this point to include the incorporation by reference statement would not constitute new matter as such statement was included with the application papers as originally filed.

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***Withdrawn Objections and/or Rejections***

Applicants note with appreciation the withdrawal of the numerous objections and/or rejections inventoried on pages 2-5 of the Office Action.

***Rejection under 35 U.S.C. § 112, Second Paragraph***

Claims 9 and 10 are rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The Examiner asserts that claims 9 and 10 are indefinite for reciting the term "reporter gene." Applicants respectfully disagree. However, without acquiescing to the rejection and in order to expedite prosecution of the application, claims 9 and 10 have been amended in accordance with the Examiner's helpful suggestion to recite "reporter" instead of "reporter gene". Applicants submit that the rejection is not applicable to claims 9 and 10 as presented herein and should be withdrawn.

***Claim Objections***

On page 14 of the Office Action, the Examiner indicates that claims 7, 8, 12, 13, 15, 21, 22, 26-34 are objected to as being dependent on a rejected based claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

In view of this indication, claim 1 has been amended to incorporate the limitations of claims 11 and 12 and claims 11 and 12 have therefore been cancelled. In view of the incorporation of the limitations of claims 11 and 12 into claim 1, claims 6, 8-10, 14 and 22 have been amended as shown above and claims 7 and 21 have been cancelled. Accordingly, claim 1 as presented herein and claims 2-4, 6, 8-10 and 14-20 and 22-25 depending directly or indirectly from claim 1 are in condition for allowance.

Likewise, claim 26 has been rewritten in independent form and incorporates all the limitations of pending claims 1-4. Accordingly, claim 26 as presented herein and claims 27-34 depending directly or indirectly from claim 26 are in condition for allowance.

Claim 35 has been amended to multiply depend from claim 2 and 26 and claim 36 has been amended to depend from claim 35. Therefore, claims 35-38 are in condition for allowance inasmuch as they depend directly or indirectly from claim 2 or 26.

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***Rejection under 35 U.S.C. § 103***

Claims 1-4, 11, 14, 16, 17, 35 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,159,705 to Truchcart, *et al.* (hereinafter "Truchcart") in view of Cappellaro, *et al.* (EMBO J. 10:4081-4088, 1991; hereinafter "Cappellaro").

Claims 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Truchcart in view of Cappellaro as applied to claims 1-4, 11, 14, 16, 17, 35 and 38 in view of Alberts, *et al.* (Molecular Biology of the Cell, 2<sup>nd</sup> Edition, Garland Publishing, Inc., 1989; hereinafter "Alberts").

Claims 18-20 and 23-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Truchcart in view of Cappellaro and further in view of both Alberts and Nare, *et al.* (Analytical Biochemistry, 267:390-396, 1999; hereinafter "Nare").

Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Truchcart in view of Cappellaro as applied to claims 1-4, 11, 14, 16, 17, 35 and 38 in view of U.S. Patent No. 6,037,131 to Reppert (hereinafter "Reppert").

All the foregoing rejections are based on the Examiner's arguments of record. Applicants respectfully disagree for the reasons of record and reiterate those reasons here.

However, without acquiescing to the rejections and in order to expedite prosecution of the application, claims 1, 6, 8-10, 14, 22, 26, 35 and 36 have been amended as set forth above and claims 7, 11-13, 21 and 39-42 have been cancelled without prejudice or disclaimer. The rejections are moot as to the cancelled claims. The rejection does not apply to claims 1-4, 6, 8-10, 14-20 and 22-38 as presented herein for the reasons given above. Applicants submit that claims 1-4, 6, 8-10, 14-20 and 22-38 are in condition for allowance.

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**CONCLUSION**

In view of the foregoing, Applicants respectfully request consideration and entry of the amendments and remarks presented herein, and allowance of this application with claims 1-4, 6, 8-10, 14-20 and 22-38. If a telephone conference would be helpful to expedite further prosecution and allowance of this application, Applicants respectfully request the Examiner to contact the undersigned at the telephone number indicated below.

Dated: November 30, 2006

Respectfully submitted,

By 

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